

### **REMARKS**

Applicants appreciate the Examiner's thorough consideration provided in the present application. Claims 1 and 3-18 are currently pending in the instant application. Claims 6, 7 and 17 have been amended to address minor editorial issues identified by the Examiner. Claims 1, 9, 13, 17 and 18 are independent. Reconsideration of the present application is earnestly solicited.

#### **Allowable Subject Matter**

Applicants appreciate the Examiner's indication of allowable subject matter. Specifically, claims 9-12 and 17 have been allowed by the Examiner. In addition, as described in greater detail hereinafter, Applicants submit that all of the claims should be allowed and the present application should be passed to Issue.

#### **Reasons for Entry of Amendments**

As discussed in greater detail hereinafter, Applicants respectfully submit that the rejections under 35 U.S.C. § 103(a) are improper and should be withdrawn. In addition, the Examiner has not provided Applicants with any reason as to why the Office Action has been made final. Accordingly, the

finality of the Final Office Action mailed on November 10, 2004 should be withdrawn.

If the Examiner persists in maintaining his rejections, Applicants submit that this Amendment was not presented at an earlier date in view of the fact that Applicants are responding to a new ground of rejection set forth in the Final Office Action and the Examiner's use of Official Notice, and Applicants' timely and repeated traverse, in a Final Office Action. In accordance with the requirements of 37 CFR 1.116, Applicants respectfully request entry and consideration of the foregoing amendments as they remove issues for appeal (minor editorial errors identified by the Examiner have been made as requested in the Office Action).

### **Priority**

Applicants appreciate the Examiner's indication of acceptance of the certified copy of the corresponding priority document for the present application.

### **Drawings**

Applicants respectfully request approval of the formal drawings filed on July 1, 2003. Since the Examiner has not cited any informalities with the drawings, Applicants submit that the formal drawings should be approved. In the absence of additional comments from the Examiner, Applicants will not take any further action with respect to the drawings.

### **Claim Rejection Under 35 U.S.C. § 112**

Claims 6 and 7 have been rejected due to the presence of alleged informalities with these claims. This rejection is respectfully traversed.

In light of the foregoing amendments to the claims, Applicants respectfully submit that these rejections have been obviated and/or rendered moot. Applicants respectfully submit that the foregoing amendments have been made to merely clarify the claimed invention as these alleged informalities should have been merely objected to by the Examiner.

Without conceding the propriety of the Examiner's rejections, but merely to timely advance the prosecution of the application, Applicants have incorporated the changes recommended by the Examiner. Applicants submit that the requested changes do not appear to either raise a substantial question

of the patentability of the claimed invention nor do they narrow the scope of the claimed invention.

**Claim Rejection Under 35 U.S.C. § 103**

1, 3, 4, 6-8 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Oguri in view of Official Notice. Claim 5 and 13-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Oguri in view of Official Notice, and further in view of Shinobu (Japanese Patent Abstract No. 60179328 A). These rejections are respectfully traversed.

In light of the foregoing amendments to the claims, Applicants respectfully submits that all of the rejections have been obviated and/or rendered moot. Specifically, Applicants submits that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention. Accordingly, this rejection should be withdrawn.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of: "an output shaft driven gear fixed to said output shaft, said output shaft driven gear meshing with said forward drive gear and said second intermediate gear, *wherein said output shaft driven gear is the only gear attached to said*

*output shaft.*” (Emphasis Added) Accordingly, this rejection should be withdrawn.

With respect to claim 13, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of: “an output shaft driven gear fixed to said output shaft, said output shaft driven gear meshing with said forward drive gear and said second intermediate gear, *wherein said output shaft driven gear is the only gear attached to said output shaft.*” (Emphasis added) Accordingly, this rejection should be withdrawn.

With respect to claim 18, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of: “a gear selecting and fixing device axially and movably mounted on said countershaft for selectively engaging said forward drive gear and said reverse drive gear to said countershaft, *wherein said gear selecting and fixing device is a manually operated dog clutch.*” (Emphasis added) Accordingly, this rejection should be withdrawn.

Applicants appreciate the Examiner’s clarifying statements in the Final Office Action concerning the rejections under 35 U.S.C. § 103(a) in view of the Oguri patent. Applicants respectfully traverse the Examiner’s positions stated in the Final Office Action.

With respect to *Point 1* identified on page 5 of the Final Office Action, the claims have effectively been rejected based on Oguri in view of Official Notice. The Examiner has also stated that Applicants position is that the modification of Oguri would render Oguri “non-functional.” Applicants admit that the Oguri transmission may function as modified by the Examiner, but certainly not for its originally intended purpose. Accordingly, this rejection is improper and should be withdrawn.

The Examiner has relied upon the *In Re Karlson* case to modify Oguri so that the output shaft includes only a single output gear. Applicants submit that *In Re Karlson* does not stand for the premise that primary references may be modified without any teaching or suggestion in the references themselves. Therefore, the Examiner must point to an actual teaching or suggestion in the prior art of record to support the modification advanced by the Examiner. Alternatively, if the Examiner is relying upon the knowledge of one of ordinary skill in the art to modify the Oguri reference (Official Notice), Applicants respectfully traverse the Examiner’s use of Official Notice and submit that the Examiner must augment the record with actual teachings or suggestions to support his opinions. Applicants submit that *In Re Karlson* does not permit the Examiner to simply remove elements of the Oguri transmission without providing actual teachings or suggestions to support this alteration.

Specifically, the driven gears that are allegedly being removed are necessary structure provided for the expressed, intended purpose of the Oguri, automatic transmission. Accordingly, this rejection is improper.

With respect to *Point 2* identified on page 5 of the Final Office Action, Applicants submit that the Examiner has merely indicated that it could have been possible, i.e., "it is considered acceptable to change the actuation means mean back to a manual means, to alter the Oguri transmission to include a manual clutch. However, the Examiner has not identified any reasons in the references themselves that identifies why one of ordinary skill in the art *would* modify Oguri to be a manual transmission when the entirety of the reference is directed at improvements for Automated Manual Transmissions (AMT), i.e., automatic transmissions. Accordingly, this rejection is improper and should be withdrawn.

As admitted by the Examiner, the automatic transmission of Oguri does not teach or suggest an output shaft, an output shaft driven gear fixed to the output shaft, the output shaft driven gear meshing with a forward drive gear and a second intermediate gear. In addition, Oguri does not teach or suggest that the output shaft driven gear is the only gear attached to the output shaft. In Oguri, the output shaft (element 14) clearly and purposefully is provided with a forward driven gear (23b), a first driven gear (21b), a second driven gear

(22b), a third driven gear (23b), a fourth driven gear (24b), a fifth driven gear (25b) and a sixth driven gear (26b). All of these gears are provided in operative engagement with corresponding drive gears (21a-26a) that are specifically mounted on an input shaft (13) to provide a forward drive train. Accordingly, this rejection should be withdrawn.

Applicants submit that these rejections based upon the Oguri reference are improper and/or fail to establish a proper prima facie case of obviousness. Accordingly, the foregoing amendments and the enclosed remarks have not been made responsive to a proper statutory rejection advanced by the Examiner.

Applicants respectfully traverse the Examiner's use of Official Notice to allegedly cure the deficiencies of the Oguri reference. The Examiner has admitted that Oguri does not teach or suggest that the output shaft driven gear is the only gear attached to the output shaft. In Oguri, the output shaft (element 14) clearly and purposefully is provided with a forward driven gear (23b), a first driven gear (21b), a second driven gear (22b), a third driven gear (23b), a fourth driven gear (24b), a fifth driven gear (25b) and a sixth driven gear (26b). All of these gears are provided in operative engagement with corresponding drive gears (21a-26a) that are specifically mounted on an input shaft (13). The Examiner has indicated that it would have been obvious to one



of ordinary skill in the art to “modify Oguri to omit the remaining gears of different ratios on the output shaft, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184.” (see page 3 of the Office Action) These gears cannot be merely omitted as suggested by the Examiner. These gears are all provided in operative engagement with corresponding drive gears. Further, Oguri’s automatic transmission is specifically directed at an “automatic transmission for a vehicle having a plurality of gear trains” (see any of the claims of Oguri and Abstract). Omitting these gears as alleged by the Examiner would clearly be in direct contrast to the expressed teachings of Oguri and clearly result in an inoperative, automatic transmission without a plurality of gear trains.

*In re Karlson* clearly does not support the modification of Oguri suggested by the Examiner. Applicants submit that in this case, the rejection discussed by the court involved a secondary teaching from a secondary reference. Therefore, this case in no way permits Examiners to omit structural details, particularly essential features, from references without supporting evidence from the prior art of record. Further, omitting the gears referred to by the

Examiner will render the Oguri device inoperative as specifically intended. Accordingly, this rejection is improper and should be withdrawn.

With respect to the Examiner's suggestion that Oguri teaches or suggests a manual transmission, this opinion is respectfully traversed. Applicants submit that Oguri is specifically directed at an automatic transmission. The alleged "manual transmission" of Oguri in col. 1 referred to by the Examiner is related only to the background art. Oguri specifically avoids any manual features as Oguri is purposefully directed at an automatic transmission (see Title, Abstract and the claims), i.e., not a manual transmission. "It is an object of the present invention to provide an AMT [Automatic Manual Transmission] type automatic transmission capable of reducing the number of gears of gear trains and the longitudinal size of the automatic transmission." Therefore, the Examiner's suggestion that it would have been obvious to "modify Oguri to employ a manual operated dog clutch, since Oguri teaches of a manual transmission (Col. 1) and in order to provide more control to the operator" (see page 4 of the Office Action) is in direct contrast to the expressed teachings and intended purpose of Oguri. Accordingly, this rejection is improper and should be withdrawn.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicants respectfully submit that these documents, either in

combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

As to the dependent claims, Applicants respectfully submit that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

### **CONCLUSION**

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of-the-art, no further comments are deemed necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

Docket No. 0505-1206P

Appl. No.: 10/609,415

Art Unit: 3681

Amendment dated February 10, 2005

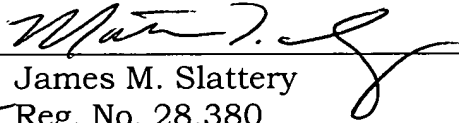
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #47,074  
James M. Slattery  
Reg. No. 28,380

  
JMS/MTS/cl

P. O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000